

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 21, 2005. At the time of the Office Action, Claims 1-5, 10-14, and 58-107 were pending in this Application. Claims 1-5, 10-14, and 58-65 were rejected. Claims 6-9 and 15-18 have been cancelled without prejudice or disclaimer. Claims 19-57 were previously cancelled due to an election/restriction requirement. Claims 66-107 were withdrawn by the Examiner due to an additional election/restriction. Claims 1, 10, and 58-65 have been amended to further define various features of Applicant's invention. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1-5, 10-14, and 58-65 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,097,846 issued to Clauss Burkart Strauch ("Strauch") and in view of U.S. Patent No. 6,613,753 issued to Joseph Rubinfeld et al. ("Rubinfeld"). Applicant respectfully traverses and submits the cited art combination, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

All pending claims are directed to filters which include the nucleic acid apurinic acid. Apurinic acid is a nucleic acid. The filters of the invention are useful for removal of carcinogens from, *e.g.*, cigarette smoke. (*See* page 6, lines 1-8)

Strauch cited by the Examiner relates to “Nasal Inhalers” for application of medications, *e.g.*, Strauch teaches his nasal inhaler is “provided with an absorbent filter adapted to filter air or smoke and preferably carry at the same time medications through the inhaled air.” (Col. 1, lines 1-9) Strauch does not teach or suggest the removal of carcinogens from cigarette smoke but the opposite--Strauch’s invention is directed to allowing carcinogens to pass into the lungs of a user and at the same time also carrying along with the carcinogens some type of medication. No specific medications are disclosed. It is clear, however, that Strauch in no way teaches the filtering out of carcinogens or the filtering out of carcinogens using the nucleic acid apurinic acid.

Rubinfeld *et al* cited by the Examiner is directed to “Restore Cancer-Suppressing Functions to Neoplastic Cells through DNA Hypomethylation.” Basically, Rubinfeld is directed to a method of treating cancer, not preventing it and certainly not preventing it from the filtering out of carcinogens from, *e.g.*, cigarette smoke or using apurinic acid to do so. For example, Rubinfeld *et al* teach: “The method comprises: delivering to a patient suffering from cancer a therapeutically effective amount of a DNA methylation inhibitor” (Abstract) The pending claims are not directed to treating cancer or delivering a therapeutic amount of any agent to a user. Just the opposite, the present invention is directed to the blocking or inhibition of the delivery of cancer causing agents, *i.e.*, carcinogens. For example, carcinogens are filtered out of the smoke by the apurinic acid contained in the filter. And it is unclear why the Examiner considers apurinic acid, a nucleic acid, as an anti-neoplastic or anti-cancer agent as disclosed in Rubinfeld *et al*. Apurinic acid is certainly not mentioned in Rubinfeld *et al* as such and Rubinfeld *et al* is directed to anti-neoplastic or anti-cancer agents that are effective in treating abnormal cell proliferation such as cancer. The present inventive claims are directed to the non-delivery or removal of carcinogens before they enter a human, not the treatment of carcinogens in the human body.

The combination of Strauch and Rubinfeld *et al* would certainly, even if proper, not yield the claimed invention. The combination of Strauch with Rubinfeld *et al* would, at best, teach the nasal delivery of anti-neoplastic agents of Rubinfeld *et al* with Strauch's nasal inhaler. Neither Strauch nor Rubinfeld *et al* teach the inhibition or blocking, *e.g.*, filtering out, of carcinogens using any means and certainly do not teach or suggest, alone or in combination, the use of the nucleic acid, apurinic acid, to reduce or remove carcinogens from a source, *e.g.*, cigarette smoke. Applicant respectfully submits all claims are allowable over the cited art and requests favorable action.

Information Disclosure Statement

Applicant appreciates Examiner's review and consideration of the references submitted in the Information Disclosure Statement and PTO Form 1449 filed March 16, 2005, however, Applicant would like to bring to the Examiner's attention that reference "U" was not considered. Applicant attaches a copy of the Information Disclosure Statement and PTO Form 1449 filed March 16, 2005 for the Examiner's convenience and a copy of the postcard receipt evidencing receipt by the Patent Office. Applicant respectfully requests that Reference "U" be considered and cited in the examination of the above-referenced application.

CONCLUSION

Applicant has now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of Claims 1, 10, and 58-65 as amended.

Applicant encloses a Petition for Three Month Extension of Time and authorizes the Commissioner to charge the \$510.00 fee to Deposit Account No. 50-2148 of Baker Botts L.L.P. Applicant believes there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2606.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicant

A handwritten signature in black ink, reading "Bruce W. Slayden II". The signature is stylized with a large, sweeping "B" and a distinct "II" at the end.

Bruce W. Slayden II
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Date: May 10, 2006

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